

Application No.: 10/772,703

2

Docket No.: 297912002103

Claim 42 recites as follows: "A radially expandable tube consisting of extruded expanded polytetrafluoroethylene having a microstructure of nodes interconnected by fibrils and having an original inner diameter, wherein said tube is radially pre-dilated from said original inner diameter to an expanded diameter that is at least two times said original inner diameter and is sintered to contract said tube from said expanded diameter to a contracted diameter that is substantially the same as said original inner diameter, said tube exhibiting a radial expansion ratio of 1.0."

Claim 42 requires, *inter alia*, that the claimed tube "is radially pre-dilated from said original inner diameter to an expanded diameter" and "is sintered to contract said tube from said expanded diameter to a contracted diameter." Each of these limitations could be considered "method limitations" as each requires a certain processing step to be performed to arrive at a tube "exhibiting a radial expansion ratio of 1.0."

The Examiner purportedly finds support for the rejection of claim 42 in the '153 patent to Gore. In the supporting statements for the rejection, the Examiner first cites to a section of the '153 patent teaching the radial dilation of a tube, giving patentable weight to the first of the two "method limitations" only "insofar as the polytetrafluoroethylene of the prior art must be capable of expanding to the extent claimed" and then states that the second of these limitations is not afforded any patentable weight because "the method of forming the tube is not germane to the issue of patentability of the tube itself." Moreover, the Examiner states that the limitation of the "tube exhibiting a radial expansion ratio of 1.0" is not germane to the issue of patentability of a final product because it is related to "an intermediate product."

First, with respect to the two "method limitations," both should be afforded patentable weight and considered by the Examiner in his comparison with the prior art of record. In particular, "product claims may be drafted to include process steps to wholly or partially define the claimed product" and "to the extent that the process limitations distinguish the products over the prior art, they must be given the same consideration as traditional product characteristics." (*In re Hallman*, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981)). Applicant notes that the aforementioned

oc-292676

Application No.: 10/772,703

3

Docket No.: 297912002103

requirement is distinguishable from the line of cases (discussed in MPEP 2115) holding that functional features of an apparatus in an apparatus claim must be differentiated from the prior art if the limitations at issue are found to be inherent in the prior art reference. (see *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)).

Second, the limitation directed to radial expansion ratio is with respect to the final product, not an intermediate product. Radial expansion ratio (RER) is defined on page 7 of the specification as a calculation based on a number of factors, including maximum inflation pressure, burst inflation pressure, and percent of radial dilation at these two pressures. The tests performed and documented in Tables I-XVII are with respect to final tube products, such as those described in Examples 1-5, not intermediate products.

Applicant therefore respectfully submits that the '153 patent does not anticipate claim 42 for at least the following reasons. Initially, the '153 patent teaches that the tube is cooled with cold air, following radial dilation and heating (col. 14, lines 49-60), rather than being "sintered to contract said tube from said expanded diameter to a contracted diameter that is substantially the same as said original inner diameter" as claimed. Thus, the teaching of the '153 patent is to a tubing that is locked in its radially expanded configuration ("with the pressure maintained in the tubing so that no collapse took place, the temperature was raised to about 360°") in contradistinction to the claimed invention of a tube that is sintered to contract the tube from the expanded diameter to a contracted diameter. This is a clear distinction between the claimed invention and the teaching of the '153 patent. In addition, there is simply no disclosure in the '153 patent for a "tube exhibiting a radial expansion ratio of 1.0." Therefore, applicant requests the withdrawal of the rejection of claim 42.

With respect to the rejections of the dependent claims under 35 USC §103(a), applicant submits that each is dependent on a patentable claim and therefore is itself patentable.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to

oc-292676

Application No.: 10/772,703

4

Docket No.: 297912002103

withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 297912002103. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: March 11, 2005

Respectfully submitted,

  
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oc-292676